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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,953	09/17/2001	Junzo Sunamoto	Yanagihara Case 62	4435

7590 11/24/2009

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EXAMINER	
CHONG, YONG SOO	
ART UNIT	PAPER NUMBER
1627	
MAIL DATE	DELIVERY MODE
11/24/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	09/936,953	SUNAMOTO ET AL.	
	Examiner	Art Unit	
	Yong S. Chong	1627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *14 August 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,4,5 and 8-12* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1, 4-5, 8-12* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Status of the Application

This Office Action is in response to applicant's arguments filed on 8/14/09. Claim(s) 2-3, 6-7 have been cancelled. Claim(s) 1, 4-5, 8-12 are pending. Claim(s) 1, 4-5, 8-12 have been amended. Claim(s) 1, 4-5, 8-12 are examined herein.

Applicant's arguments have been fully considered but found not persuasive. The rejection of the last Office Action is maintained for reasons of record and repeated below for Applicant's convenience. The following new rejection will also apply.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 4-5, 8-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

There is no support in Applicant's disclosure for the limitation "unemulsified."

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in Graham vs John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 4-5, and 8-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sunamoto et al. (English Translation of JP 03-292301) in view of Ishiwatari et al. (US Patent No. 6,074,652).

Sunamoto et al. disclose polysaccharide-sterol derivatives. Exemplified is an emulsion comprising 10 mg oil (glycerol tricaprylate, a cosmetic component), 5 mg pullulan-cholesterol derivative, and 1 mL water (a cosmetic component), a percent weight of 0.5% pullulan cholesterol derivative and 95.5% cosmetic components (oil and water), see page 14. For the pullulan-cholesterol derivative having the structure of formula (1) of the instant claims, see page 2, claim 1. For 0.1 - 6 units per 100 monosaccharide units, see page 2, claim 1.

It is respectfully pointed out that a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior ad. See In re Casey, 152 USPQ 235 (CCPA 1967) and In re Otto, 136 USPQ 458, 459 (CCPA 1963). Thus, the intended uses of claims 8 and 9 are not afforded patentable weight.

It is further respectfully pointed out that the recitation "cosmetic" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See In re Hirao, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and Kropa v. Robie, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Sunamoto et al. does not teach a solvent containing at least one of a volatile oil and a volatile solvent or wherein said cosmetic components additionally comprise at least one member selected from moisture-preserving agents, UV absorbers, beauty whitening agents, inorganic pigments etc... or wherein the solvent comprises a volatile hydrocarbon oil having a boiling point at normal pressure in the range from 60-160 °C.

Ishiwatari et al. teach, in col. 1 line 40 to col. 2 line 45, an oil-in-water emulsified composition which has good usability and stability comprising an α-monoalkyl glyceryl

ether, a wax, and a silicone oil, and can contain a higher alcohol, a water-soluble high polymer, an humectant, and a UV-protecting agent and film forming agent.

Ishiwatari et al. teach, in col. 5 lines 5-10, the preferred silicone oils can be volatile or non-volatile, straight chain or cyclic, and with specific embodiments being dimethylpolysiloxane, decamethylcyclopentasiloxane, and methylphenylpolysiloxane.

Ishiwatari et al. teach, in col. 10 lines 55-67, that the oil-in-water emulsified composition can be stabilized by addition of water-soluble high polymers such as polysaccharides.

Ishiwatari et al. teach, in col. 11 lines 15-35, that the oil-in-water emulsified compositions are to be used in the formulation of cosmetic products. In example 1-1 a cosmetic cream formulation is presented comprising a water phase and an oil phase. In the oil phase octamethylcyclotetrasiloxane (30% by weight) and dimethylpolysiloxane (3% by weight) are present. The examiner notes that both of these siloxanes meet the applicant's examples of a volatile solvent and a volatile oil having a boiling point between 60-160 °C. Additionally the water phase contain the humectants malitol and glycerin (moisture-preserving agents).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the pullulan-sterol compositions of Sunamoto et al. in the cosmetic water-in-oil emulsions of Ishiwatari et al. as pullulan-sterol compositions had previously been used in the formulation of emulsions (and liposomes) and that the pullulan-sterol emulsions exhibited improved chemical and physical stabilities. One would have been motivated to use the pullulan-sterol compounds in the Ishiwatari et al

cosmetic emulsions in order to take advantage of the improved chemical and physical stability exhibited by the pullulan-sterol compounds.

Examiner notes that all elemental steps of the claimed invention have been met by the cited prior art. Therefore, since all components of the composition have been taught, all properties are obvious.

"Products of identical chemical composition can not have mutual exclusive properties." Any properties exhibited by or benefits from are not given any patentable weight over the prior art provided the composition is inherent. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the disclosed properties are necessarily present. *In re Spada*, 911 F.2d 705, 709, 15 USPQ 1655, 1658 (Fed. Cir. 1990). See MPEP 2112.01. The burden is shifted to the applicant to show that the prior art product does not inherently possess the same properties as the instantly claimed product.

Response to Arguments

Applicant argues that the Sunamoto reference does not teach an unemulsified cosmetic product because several examples are in the form of emulsions.

This is not persuasive because all of the claimed components of the invention have been taught by the cited prior art references. Therefore, the limitation "unemulsified" is obvious since a composition and its properties are inseparable. Applicant is requested to show factual evidence in the form of a side by side comparison with the claimed invention as to why the composition rendered obvious by the cited prior art is an emulsion.

Applicant also argues that Sunamoto has no disclosure with respect to a solvent containing at least one of a volatile oil and a volatile organic solvent or the use of the polysaccharide-sterol derivative in an unemulsified cosmetic composition.

This is not persuasive because this limitation is taught in the secondary reference of the obviousness rejection.

In response to applicant's arguments against the references, one cannot show nonobviousness by attacking references individually where the rejections are based on the combination of references. See *In re Keller,* 642 F. 2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F. 2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant argues that the secondary reference, Ishiwatari provides no motivation to modify Sunamoto in a manner that would yield the presently claimed invention. This is not persuasive because It would have been obvious to one of ordinary skill in the art at the time because pullulan-sterol compositions had previously been used in the formulation of emulsions (and liposomes) and that the pullulan-sterol emulsions exhibited improved chemical and physical stabilities. One would have been motivated to use the pullulan-sterol compounds in the Ishiwatari et al cosmetic emulsions in order to take advantage of the improved chemical and physical stability exhibited by the pullulan-sterol compounds.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong S. Chong whose telephone number is (571)-272-8513. The examiner can normally be reached on M-F, 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, SREENI PADMANABHAN can be reached on (571)-272-0629. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Yong S. Chong/
Primary Examiner, Art Unit 1627

YSC